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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,453	09/22/2005	Gianni Silvestri	71678	8700

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EXAMINER
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HUNNINGS, TRAVIS R

ART UNIT	PAPER NUMBER
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2612

MAIL DATE	DELIVERY MODE
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07/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/522,453

Applicant(s)

SILVESTRI, GIANNI

Examiner

Travis R. Hunnings

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 4, 5 and 7-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Regarding claim 1, the phrase "or the like" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "or the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).
4. Claim 1 recites the limitations "the number/name" "the size" "the color" "the safety class" "the date of manufacture" "the user" throughout the claim. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 4 recites the limitation "the class" "the peculiar characteristics" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2612

6. Claim 5 recites the limitation "the user" in line 2. There is insufficient antecedent basis for this limitation in the claim.

7. Claim 7 recites the limitation "the insole" and "the sole" in line 2. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 8 recites the limitation "the upper or accessory parts" in line 2. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 9 recites the limitation "the bottom" "the material" "the molded sole" throughout the claim. There is insufficient antecedent basis for this limitation in the claim.

#### ***Claim Objections***

10. Claim 6 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should be in the alternative form only and the phrase "at least one" implies one or more. See MPEP § 608.01(n). Accordingly, the claim has been treated as if it were dependent on claim 1.

#### ***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2612

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Ormanns et al. (Ormanns; US Patent 4,870,700).

Regarding claim 1, Ormanns discloses *Personal Safety Radio Device* that has the following claimed limitations:

The claimed working shoe provided with a transponder designed to supply data to allow identification of the shoe is met by the personal safety radio device being placed in a shoe, as shown in figure 2. The radio device having a unique identifier for tracking of the device/user wearing the device (column 4, lines 42-58);

The claimed allowing identification of the user by means of a univocal code contained in the transponder is met by the radio device having a unique identifier for tracking of the device/user wearing the device (column 4, lines 42-58).

Regarding claim 2, the claimed transponder being incorporated in the device so as to make any loss and/or replacement reasonably difficult and/or easy to identify is met by the device being placed in the sole of the shoe as seen in figure 2 and therefore removing the device would require the destruction of the sole of the shoe which one of ordinary skill in the art would consider easily identifiable.

Regarding claim 3, the claimed transponder being positioned in a way that it may be recovered and re-used is met by the device being placed in the sole of the shoe as seen in figure 2, and retrieving the device by removing the sole and placing the device in another shoe sole.

Regarding claim 4, the claimed transponder allowing identification of the class and/or the peculiar characteristics and verification of its consistency in the case of access to specific working areas is met by the device being used in particular in underground areas for determining when the user has walked through particular barriers, or locks or individual operational areas (column 4, lines 42-58).

Regarding claim 5, the claimed transponder allowing identification of the user is met by the unique identifier in the device (column 4, lines 42-58). The claimed guaranteed recovery after cumulative treatments of a plurality of said shoes, such as washing, sterilization and other types of treatments is merely the intended use of the device.

Regarding claim 6, the claimed transponder being incorporated in the bottom of the shoe is met by the device being placed in the shoe as seen in figure 2.

Art Unit: 2612

Regarding claim 7, the claimed transponder being inserted between the insole and the sole of the shoe is met by the device being placed in the shoe as seen in figure 2.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ormanns.

Regarding claim 9, Ormanns does not specifically disclose the claimed process of making the shoe and inserting the transponder in the molded sole of the shoe. However, it would have been obvious to one of ordinary skill in the art that the process claimed is a well-known process for making shoe soles and that in order to make the shoe with the device placed in the sole as shown in figure 2 placing the device in the mold. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device disclosed by Ormanns to place the device in an injection mold in order to form the device in the sole of the shoe.

Art Unit: 2612

15. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ormanns in view of Musa (US Patent 5,557,259).

Regarding claim 8, Ormanns does not specifically disclose the claimed transponder being inserted in the upper or accessory parts of the upper in a specific housing. Musa discloses *Proximity Alert And Direction Indicator* that teaches a transponder device that is placed in the upper portion of a shoe as seen in figures 2 and 3. Moving the device of Ormanns to the upper part of the shoe would allow the user easier access to the device in order to fix or replace faulty devices. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the device disclosed by Ormanns according to the teachings of Musa to place the transponder in the upper part of the shoe.

### ***Conclusion***

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Jamal et al. *Footwear With GPS*, US Patent 6,788,200 ;

McKeown et al. *Deactivatable Security Tag*, US Patent 5,574,431 ;

Moody, *System And Method For Detecting Movement Of An Infant From A Secure Area*, US Patent 5,079,541;

Smith, *Location Tracking Of Individuals In Physical Spaces*, US Patent 6,563,423.



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis R. Hunnings whose telephone number is (571) 272-3118. The examiner can normally be reached on 8:00 am - 5:00 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel J. Wu can be reached on (571) 272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TRH

  
**BENJAMIN C. LEE**  
**PRIMARY EXAMINER**